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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,642	01/22/2004	David Howell	2103042-991100	2449

26379 7590 10/13/2006

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EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,642	Applicant(s) HOWELL, DAVID	
	Examiner James H. Blackwell	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to an amendment filed 07/10/2006 with a priority date of **01/22/2004**.
2. Claims 1-36 are pending. Claims 1, 13, and 25 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 13-15, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine (U.S. Patent Application Publication 2004/0205462 filed 01/07/2002, published 10/14/2004) in view of Ghani (U.S. Patent Application Publication No. 2002/0085030 filed 08/30/2001, published 07/04/2002), and in further view of Guck (U.S. Patent No. 5,911,776 filed 12/18/1996, issued 06/15/1999).

In regard to independent Claim 1 (and similarly independent Claims 13, and 25), Levine discloses a workflow and system for print-on-demand book reproduction starting with the input (*input module*) of both digital and hard-copy electronic versions of a work, which are then converted (*converts the input file into an intermediate format file*) to a solution-independent, intermediate format set of files that are then stored with attached metadata (title, author, publisher, ISBN, and publication date) (*a storage device comprising a storage portion that stores the intermediate format file and a*

storage portion into which a piece of work metadata associated with the input file is stored).

Levine fails to explicitly disclose the limitation of *a module that validates the input file*. However, Ghani discloses a format validator/dispatcher 1325 that validates that the file (input file) is in fact a PPT format file by examining the header information of the file and dispatches the file to the converter algorithm. Once validated and dispatched, engine 1200 using a converter algorithm then converts the slides in the PPT file into a series of JPEG format files (multiple output files) and modifies the resolution (i.e., size) and format of the JPEG file 1330 for display on whiteboard 400. Engine 1200 uses the PowerPoint COM Interfaces to convert the slides into a series of "jpg" (JPEG) images and modify the resolution. The JPEG files are modified from their standard resolution to 400 x 300 pixels. The PowerPoint application does not open the PPT file but merely performs the format conversion (Pg. 9, Paragraph [0125]; Fig. 13, steps 1325, 1330 disclose a input file validator and a converter).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Levine and Ghani as both inventions relate to the conversion of an input file to an output file in another format. Adding the disclosure of Ghani provides the benefit of input file validation thus avoiding problems brought about by the upload of an incompatible or corrupted file.

Levine and Ghani both fail to explicitly disclose the limitation of *a conversion module that generates two or more editions of a work having different formats, the two or more editions of the work being generated based on the intermediate format file and*

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the work metadata. However, Guck discloses a system that produces multiple outputs in what are called Shadow Files (see Fig. 2A).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Levine, Ghani, and Guck as all three inventions relate to pipeline conversion of source file(s) to multiple output file(s) in multiple formats. Adding the disclosure of Guck provides the benefit of files that are viewable by multiple devices and applications.

In regard to dependent Claim 2 (and similarly independent Claims 14, and 26), Levine and Ghani both fail to explicitly disclose the limitation of *a storage portion that stores a piece of form metadata associated with the intermediate format file, the form metadata specifying a form of an edition of the work*. However, Guck discloses both source file content and associated metadata describing input file type are stored in a database (Fig. 2A).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Levine, Ghani, and Guck as all three inventions relate to pipeline conversion of source file(s) to multiple output file(s) in multiple formats. Adding the disclosure of Guck, provides the benefit of using metadata to assist in determining file type and hence file conversion by choosing a compatible converter base on file type (mime type).

5. Claims 3-7, 15-19, and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine, in view of Ghani, and in further view of Guck, and in further view of McCurdy et al. (hereinafter McCurdy, U.S. Patent Application Publication No. 2002/0035697 filed 07/02/2001, published 03/21/2002).

In regard to dependent Claim 3 (and similarly independent Claims 15, and 27), Levine, Ghani, and Guck all fail to explicitly disclose the limitation of a *distribution module that distributes the one or more editions of the work*. However, McCurdy discloses the distribution of multiple files in a system that produces electronic versions of magazines (Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Levine, Ghani, Guck, and McCurdy as all of these inventions relate to pipeline conversion of source file(s) to multiple output file(s). Adding the disclosure of McCurdy, provides the benefit of a mechanism for the distribution of electronic versions of magazine content.

In regard to dependent Claim 4 (and similarly independent Claims 16, and 28), Levine fails to disclose the limitation of a *plurality of distribution channels, wherein each distribution channel receives a different edition of the work*. However, Guck discloses multiple channels for the distribution of output (Fig. 1, web, fax, telephone, mail, news requestors/retrievers). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Levine, Ghani, Guck, and McCurdy as all of these inventions relate to pipeline conversion of source file(s) to multiple output file(s). Adding the disclosure of Guck, provides the benefit of a

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mechanism for the distribution of electronic versions of content to multiple users via multiple channels.

In regard to dependent Claim 5 (and similarly independent Claims 17, and 29), Levine, fails to explicitly disclose the limitation that *the distribution module further comprises a web site into which the one or more editions of the work are loaded wherein the one or more editions of the work are available for download from the web site*. However, Ghani discloses a web server that converts and distributes (among other tasks) content (Pg. 2, Paragraph [0035]). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Levine, Ghani, Guck, and McCurdy as all of these inventions relate to pipeline conversion of source file(s) to multiple output file(s). Adding the disclosure of Ghani, provides the benefit of using a common and well known interface (web server) for the distribution of electronic versions of content to multiple users via multiple channels.

In regard to dependent Claims 6-7 (and similarly independent Claims 18-19, and 30-31), Levine, Ghani, and Guck all fail to disclose the limitation that *the distribution module distributes the one or more editions of the work to a wireless device*. However, McCurdy suggests using devices for reading magazines that make requests and receive reading materials wirelessly and also teaches the future use of Bluetooth as one possible wireless protocol for transferring reading material (Pg. 25, Paragraph [0386]). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Levine, Ghani, Guck, and McCurdy as all of these inventions relate to the collection, generation, and distribution of reading materials. Adding the

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teaching of McCurdy provides the benefit of a well-known and heavily used wireless electronic distribution method for the distribution of publications.

6. Claims 8-10, 20-22, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Ghani, and in further view of Guck, and in further view of Daniel et al. (hereinafter Daniel, U.S. Patent Application Publication 2003/0163784 filed 12/12/2002, published 08/28/2003).

In regard to dependent Claims 8-9 (and similarly independent Claims 20-21, and 32-33), Levine, Ghani, and Guck all fail to disclose a *template storage device that stores one or more templates that transform the intermediate format file into an edition of the work*. However, Daniel discusses that items uploaded for compilation into publications (teaching materials) are stored in XML and are transformed (styled) using a selection of skins (templates, style sheets) (Pg. 3, Paragraph [0025]; Pg. 12, Paragraphs [0107-0108]). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Levine, Ghani, Guck, and Daniel as all of these inventions relate to the collection, generation, and distribution of document content. Adding the teaching of Daniel provides the benefit of using templates to give the publication a specific and uniform look-and-feel.

It is noted that none of Levine, Ghani, Guck, or Daniel explicitly disclose the use of XSL-FO to style their documents. However, it would have been obvious to one of ordinary skill at the time of invention to have used XSL-FO as it represented a more advanced and particularly XML format friendly tool to use for style sheet purposes.

In regard to dependent Claim 10 (and similarly dependent Claims 22, and 34), Levine, Ghani, and Guck all fail to disclose *an edition of the work further comprises*

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an edition containing a subset of the work metadata associated with the intermediate format file. However, Daniel discloses metadata related to objects (Paragraphs [0040], [0082], [0095], [0104], [0105]). Since Daniel discloses a subset of objects, and if said objects are associated with specific metadata, it would have been obvious to one of ordinary skill in the art at the time of invention that Daniels' subset includes the metadata via its association as discloses above, providing the benefit of providing a description of the content that remains with the content.

In regard to dependent Claim 10 (and similarly independent Claims 22, and 34), Levine, Ghani, and Guck all fail to explicitly disclose *an edition containing a subset of the work metadata associated with the intermediate format file.* However, Daniel teaches that after all necessary e-content or e-learning objects are created, the author or course instructor then arranges a selected subset of the e-content or e-learning objects, representing topics and sub-topics, into a particular sequence to produce one or more larger publication or instruction objects that cover sections (i.e., module objects) into a particular sequence to define an electronic publication or CAI course. In this manner, the author, publisher or course instructor is able to assemble his or her publication or course from a plan in a modular manner, wherein each constituent object can be modified or removed, or new objects added, independently without changing content pertaining to the rest of the publication or course (Pg. 3, Paragraph [0025]). It is further noted that Daniel discloses metadata related to objects (Paragraphs [0040], [0082], [0095], [0104], [0105]). Since Daniel discloses a subset of objects, and if said

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objects are associated with specific metadata, it would have been obvious to one of ordinary skill in the art at the time of invention that Daniels' subset includes the metadata via its association as disclosed above, providing the benefit of providing a description of the content that remains with the content. It would have been additionally obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Levine, Ghani, Guck, and Daniel as all of these inventions relate to the collection, generation, and distribution of reading materials. Adding the teaching of Daniel provides the benefit of using only portions of stored materials to create documents, which are associated with metadata as disclosed by Levine. e3

7. Claims 11-12, 23-24, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Ghani, and in further view of Guck, and in further view of Barsness et al. (hereinafter Barsness, U.S. Patent Application Publication 2004/0201633 filed 09/13/2001, published 10/14/2004).

In regard to dependent Claims 11-12 (and similarly independent Claims 23-24, and 35-36), Levine, Ghani, and Guck all fail to disclose the limitation that *the feedback for an edition further comprises one or more of a number of copies of an edition sold, a sales price of an edition, a geographic distribution of the edition and demographics of final users of the edition*. However, Barsness discloses that, where the content is being created by an instructor, or any other author for that matter, the usage statistics may be utilized in revising the content, e.g., to simplify certain passages, make certain passages more understandable, etc., as shown in block 212. Once the content

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is revised, the content may optionally be redistributed to users as shown by the arrow from block 212 to block 204. The usage statistics in this application are therefore utilized to assist an author in improving the quality of authored content based upon the *usage statistic feedback generated by one or more users* (Pg. 7, Paragraph [0085]).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Levine, Ghani, Guck, and Barsness as all of these inventions relate to the collection, generation, and distribution of reading materials. Adding the teaching of Barsness provides the benefit of providing feedback to authors and publishers about their products' usage.

Response to Arguments

8. Applicant's arguments see amendment, filed 07/10/2006, with respect to the rejection(s) of claim(s) 1-4, 10, 13-16, 22, 25-28, and 34 under Levine, Daniel, McCurdy, and Barsness have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Levine, Ghani, Guck, Daniel, McCurdy, and Barsness. It is thought that the new references and their new combinations with the previous prior art disclose the claimed invention.

It is further noted that in response to Applicant's argument with respect to the prior art of Daniel regarding dependent Claim 10 (and similarly dependent Claims 22, and 34) where Applicant states that Daniel discloses a subset of e-content objects (content) assembled into a publication, whereas Claim 10 (and 20, 34) deals with a

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"subset of the works metadata" (not the content). Daniel teaches metadata related to objects (see rejection above). If Daniel teaches a subset of objects, and if said objects are associated with specific metadata, it is then obvious that Daniel's subset includes the metadata via its association as taught above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

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12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James H. Blackwell
09/28/2006

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER